

REMARKS

At the time of the Office Action dated January 26, 2005, claims 1-23 were pending in this application. Of those claims, claims 8-20 have been rejected and claims 1-7 and 21-23 have been withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Applicants acknowledge, with appreciation, Examiner's indication that claims 12-13 and 19-20 contain allowable subject matter. Claims 8, 13-15, and 19 have been amended to address informalities. Applicants submit that the present Amendment does not generate any new matter issue.

On page 3 of the Office Action, the Examiner objected to the drawings pursuant to 37 C.F.R. § 1.83(a), requiring depiction of the every feature of the invention specified in the claims. The Examiner, however, neglected to indicate what feature the Examiner believes is specified in the claims but not shown in the drawings. Although the Examiner made reference to claim 19, every feature recited in claim 19 can be found in the drawings of Applicants' disclosure. Applicants, therefore, respectfully solicit withdrawal of the imposed objection to the drawings.

CLAIMS 8-14 AND 19 ARE REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. §

112

On page 2 of the Office Action, the Examiner asserted that the claims are indefinite. Specifically, the Examiner asserted that the "positive limitation to the lateral sides of the opening ... suggests that a combination with the opening is being claimed." Applicants respectfully disagree. The opening, and lateral sides thereof, have not been positively recited in any of the

claims. Instead, the opening has only been referred to as an environment element with which the claimed strut positioning system interacts.

Notwithstanding, Applicants have amended claims 8, 13-15, and 19 to replace the term "said" with "the" when that term is used in conjunction with either the opening or lateral sides since Applicants recognize that the term "said" is customarily (but not necessarily) used with a positively recited element, whereas "the" is customarily (but not necessarily) used with an environmental element. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 8-14 and 19 under the second paragraph of 35 U.S.C. § 112.

CLAIMS 15 AND 16 ARE REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY MILLER ET AL., U.S. PATENT NO. 4,281,733 (HEREINAFTER MILLER)

On page two of the Office Action, the Examiner asserted that Miller discloses a strut positioning system corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure of each element of a claimed invention in a single reference. As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference. That burden has not been discharged. The Examiner neither clearly designated the teachings in Miller being relied upon nor clearly

explained the pertinence of Miller. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c).¹

For example, claim 15 recites "a track configured for mounting in a fixed position relative to ... the opening." The Examiner, however, has failed to establish that Miller teaches this particular limitation. The feature in Miller identified by the Examiner as corresponding to the claimed track is described in Miller as being "[a] heat exchanger or radiator 18 is mounted between a pair of upright beams 18." As readily apparent from Miller, the upright beam 18 is configured to rotate relative to the opening (unnumbered). Thus, one skilled in the art would not have identified the upright beam 18 of Miller as being comparable to the claimed track.

Claim 15 also recites that "a slide plate [is] configured for translational movement within said track from a first position to a second position." In the statement of the rejection, the Examiner identified feature 19 as corresponding to the claimed plate. Miller describes feature 19 as a "forwardly projecting brackets means 19 [that] is mounted to each of the upright beams 18." Miller, however, fails to teach that the bracket means 19 is configured for translational movement within the upright beam 18 from a first position to a second position. In contrast, Miller states that the bracket means 19 is stationary (i.e., mounted to) the upright beams 18.

¹ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

The above argued differences between the strut positioning system defined in independent claim 15 and the system of Miller undermine the factual determination that Miller identically describes the claimed invention within the meaning of 35 U.S.C. § 102. Applicants, therefore, respectfully submit that the imposed rejection of claims 15 and 16 under 35 U.S.C. § 102 for anticipation based upon Miller is not factually viable and, hence, solicit withdrawal thereof.

CLAIM 15 IS REJECTED UNDER 35 U.S.C. § 102 AS BEING ANTICIPATED BY SEDLAK ET AL., U.S. PATENT NO. 6,367,199 (HEREINAFTER SEDLAK)

On page two of the Office Action, the Examiner asserted that Sedlak discloses a strut positioning system corresponding to that claimed. This rejection is respectfully traversed.

The Examiner's sole statement with regard to this rejection is as follows:

Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Sedlak et al. Sedlak shows a strut 40, a track 22, a plate 24 and locking member 56.

The initial burden of establishing a *prima facie* case for rejecting a claim under 35 U.S.C. § 102 lies with the Examiner. Likewise, Applicants do not have an initial burden of establishing that a claimed invention is novel. However, the lack of specifics contained in the Examiner's rejection has improperly forced Applicants to establish that the claimed invention is novel over Sedlak without the Examiner first establishing that Sedlak identically discloses each element of the claimed invention with the meaning of 35 U.S.C. § 102.

The Examiner has not identified all the elements of the claims (including the claimed interactions between elements). The Examiner has not construed a meaning for each of the claimed features. The Examiner has also not identified corresponding elements in Miller for all

of the claimed elements. The Examiner asserts that "Sedlak shows a strut 40, a track 22, a plate 24 and locking member 56." However, the Examiner has failed to explain: why one skilled in the art would consider the lift mechanism 22 of Sedlak to be comparable to the claimed track; why one skilled in the art would consider the channel 24 to be comparable to the claimed plate; and why one skilled in the art would consider the pinion gear 56 to be comparable to the claimed locking member.

Applicants also note that claim 15 recites that the "slide plate [is] configured for translational movement within said track from a first position to a second position." Thus, claim 15 recites that the slide plate and track are separate elements. However, the Examiner's asserted slide plate (i.e., channel 24) is considered to be a part of the asserted track (i.e., lift mechanism 22), and there is no apparent teaching that the channel 24 of Sedlak is configured for translational movement within the lift mechanism 22. Instead, as illustrated in Figs. 5 and 6 of Sedlak, the channel 24 is stationary relative to the lift mechanism 22. Thus, Sedlak fails to identically disclose the claimed invention recited in claim 15.

For the reasons stated above, Applicants respectfully solicit withdrawal of the imposed rejection of claim 15 under 35 U.S.C. § 102 for anticipation based upon Sedlak.

CLAIMS 8-11 AND 14-18 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON BYE ET AL., U.S. PATENT NO. 4,899,420 (HEREINAFTER BYE), IN VIEW OF
TALUKDAR ET AL., U.S. PATENT PUBLICATION NO. 2003/0193199 (HEREINAFTER TALUKDAR)

On page 3 of the Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify the system of Bye in view of Talukdar to arrive at the claimed invention. This rejection is respectfully traversed.

Applicants submit that the Examiner has not established a *prima facie* basis to deny patentability to the claimed invention under 35 U.S.C. § 103 for lack of the requisite factual basis and lack of the requisite realistic motivation.² The Examiner has only identified five elements (i.e., strut, strut connecting means, track, slide plate, and pinion) in the applied prior art that corresponds to these features. However, the nine claims (i.e., 8-11 and 14-18) recite far more than five elements and the interrelationships between these elements. Thus, the Examiner has failed to identify where the applied prior art teaches or suggests each of the claimed elements.

Furthermore, Applicants note that the Examiner's motivation to combine Bye and in view of Talukdar because the parts "are capable of being used together." is legally insufficient. The mere identification of claim features in disparate references does not establish the requisite realistic motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103.³

Moreover, a generalization does not establish the requisite motivation to modify a specific reference

² In rejecting a claim under 35 U.S.C. § 103, the Examiner is required to identify a source in the applied prior art for: (1) claim limitations; and (2) the motivation to combine references or modify a reference in the reasonable expectation of achieving a particular benefit. Smiths Industries Medical System v. Vital Signs Inc., 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). In so doing, it is legally erroneous to ignore any claim limitation. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

³ Grain Processing Corp. v. American-Maize Products Co., 840 F.2d 902, 5 USPQ2d 1788 (Fed. Cir. 1988).

in a specific manner to arrive at a specifically claimed invention.⁴ Rather, a burden is imposed upon the Examiner to make "clear and particular" factual findings as to any specific understanding or specific technological principle which would have realistically impelled one having ordinary skill in the art to modify the applied prior art.⁵ In this respect, Applicants stress that the requisite motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103 requires not only a suggestion but a reasonable expectation of success as to a particular benefit.⁶ Obvious to try is not the standard.⁷ The Examiner's assertion that the parts are capable of being used together fails to establish a motivation to combine required for a rejection under 35 U.S.C. § 103 for obviousness.

Thus, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness in rejecting claims 8-11 and 14-18 under 35 U.S.C. § 103. Applicants, therefore, respectfully solicit withdrawal of the imposed rejection of claims 8-11 and 14-18 under 35 U.S.C. § 103 for obviousness based Bye in view of Talukdar.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing

⁴ In re Deuel, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995).

⁵ Ruiz v. A.B. Chance Co., 234 F.3d 654, 57 USPQ2d 1161 (Fed. Cir. 2000); Ecolochem Inc. v. Southern California Edison Co., 222 F.2d 973, 56 USPQ2d 1065 (Fed. Cir. 2000); In re Kotzaab, 217 F.3d 1365, 55 USPQ 1313 (Fed. Cir. 2000); In re Dembiczak, 175 F.2d 994, 50 USPQ2d 1614 (Fed. Cir. 1999).

⁶ In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

⁷ In re O'Farrell, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Dow Chemical Co., 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

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remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417, and please credit any excess fees to such deposit account.

Respectfully submitted,

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